

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Status of the claims

Claims 15-52 were pending and under active consideration in the subject application. No claims have been amended, deleted, or newly added with this submission. Hence, upon entry of this paper, claims 15-52 will remain pending and under active consideration.

Claim rejections under 35 U.S.C. § 103

Claims 15-22 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over DE 19519539 A1 to Hackel *et al.* (“Hackel”) in view of WO 00/73378 A1 to Dempsey *et al.* (“Dempsey”). The Examiner alleges that Hackel discloses a binder composition comprising 50-99 wt % bitumen, elastomer, and “2-25 wt% to a mono-alkyl ester of a vegetable oil.” The Examiner recognizes that Hackel is silent on “an amide additive” as well as the concentration of elastomer recited in the claims. In any event, the Examiner opines that it would have been obvious for the ordinary artisan to have combined and modified the teachings of these references to arrive at the presently claimed invention. Applicants respectfully disagree with the Examiner’s conclusion and therefore traverse the rejection.

At the outset, Applicants respectfully note that Hackel does not, in fact, teach a binder composition comprising (a) bitumen, (b) elastomer and (c) *mono-alkyl ester of a vegetable oil*. The fourth paragraph of page two of the (machine) English translation of Hackel, cited by the Examiner, merely teaches the use of rapeseed oil, which is not an ester of a vegetable oil, let alone a mono-alkyl ester of a vegetable oil.¹ In fact, according to the present invention, it is the

¹ To be sure, at page two, paragraph 6, Hackel does mention the use of “a transesterification product such as rapeseed oil methyl esters,” but “methyl esters” include trialkyl esters, dialkyl esters and mono-alkyl esters, and there is no teaching in Heckel to distinguish among them, not to mention any teaching to select mono-alkyl esters preferentially.

mono-alkyl ester of the vegetable oil that is responsible for advantageously reducing the viscosity of the bituminous binder composition. *See, e.g.*, page 6, 2nd paragraph. Dempsey does not cure this deficiency.

The remaining claims stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hackel in view of Dempsey, and further in view of USP No. 4,129,542 to Matheson *et al.*, USP No. 6,444,731 to Memon, and/or U.S. publication no. 2004/0033308 to Barthel *et al.* Applicants respectfully traverse these rejections.

Applicants respectfully submit that the additional secondary references—namely, Matheson, Memon, and Barthel—each fail to teach the specific use of a mono-alkyl ester of a vegetable oil. Hence, insofar as the present combination of references fails to meet a threshold for establishing a *prima facie* case for obviousness requiring that each and every element of the claimed invention be taught in some combination of references, Applicants respectfully submit that the rejections for obviousness be withdrawn.

Conclusion

Applicants believe that the present application remains in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37

C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

By 

Date January 27, 2009

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